IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1936

No.

THE MANTLE LAMP COMPANY OF AMERICA,
Petitioner,

vs.

ALUMINUM PRODUCTS COMPANY,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT AND BRIEF IN SUPPORT THEREOF.

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To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:

The petitioner, The Mantle Lamp Company of America, prays that the writ of certiorari issue to the Circuit Court of Appeals for the Seventh Circuit to review a judgment of that court rendered on November 28, 1936 in the above entitled cause (Tr. 494). A transcript of the record in the case, including the proceedings in said Circuit Court of Appeals, is furnished herewith in accordance with rule 38 of the rules of this Court.

I.

SUMMARY STATEMENT OF MATTER INVOLVED.

A. History of the Litigation.

The patent involved in this infringement suit, Blair No. 1,435,199, was held invalid as to the claims in suit by the District Court for the Northern District of Illinois because of lack of invention, for anticipation, for aggregation, and as arising from mechanical skill only (Tr. 325). All of the claims of the patent were held invalid for unreasonable delay and neglect in filing disclaimers (Tr. 325).

The Blair patent (Tr. 342) covers a heat-insulated receptacle of the non-vacuum type. The dominant structural characteristic of the invention consists in hanging a large and heavy, frangible (although sturdy) container to an outer metallic jacket at the necks of each, by means of an intervening element which serves the dual purpose of (1) bonding the frangible container and its protective metallic shell together at one point only, and (2) sealing out heat-conducting moisture from the insulation material between the walls of the container and the metallic jacket. The invention avoids supporting the container from below, and limits any contact between the container and the jacket to the narrow band at the neck through the interposed insulating bond. All channels for heat exchange, whether by conduction, convection, or radiation, are obviated.

The patent in suit was first found invalid for lack of invention by the Circuit Court of Appeals for the Seventh Circuit in two cases that were heard together, namely, *Macomb Manufacturing Company* v. *The Mantle Lamp Company of America*, 22 Fed. (2) 93, and *Monarch Company, Inc., et al.* v. *The Mantle Lamp Company of America*,

22 Fed. (2) 95, reversing decrees of the District Courts for the Southern District of Illinois and for the Northern District of Illinois, Eastern Division, respectively, both District Courts having held the patent valid and infringed. Rehearing in both cases was denied by the Circuit Court of Appeals for the Seventh Circuit on December 5, 1927.

Upon denial of its petitions for rehearing in the said *Macomb* and *Monarch* cases, Petitioner proposed to and did endeavor to bring to trial its prior co-pending case entitled *The Mantle Lamp Company of America* v. *The Cutino Company* in the District Court of the United States for the Western District of Missouri.

On January 3, 1928, the Monarch Company, one of the successful litigants in the cases before that time decided by the Circuit Court of Appeals for the Seventh Circuit, filed its bill to enjoin the prosecution of said pending case against The Cutino Company in the District Court of Missouri, alleging The Cutino Company to be its customer. Preliminary injunction being denied, an appeal to the Circuit Court of Appeals for the Seventh Circuit was successful in preventing a trial of said *Cutino* case, and Petitioner, on October 8, 1928, was enjoined from further prosecution of said pending case in the Eighth Circuit. The injunction has but recently been dissolved.

Prior to the issuance of said preliminary injunction enjoining the prosecution of the Kansas City case and on September 12, 1928, Petitioner filed its bill for infringement in the District Court for the Northern District of Ohio against the George H. Bowman Company (it being neither a customer of the Monarch Company nor the Macomb Manufacturing Company). That Court, following the opinions of the Seventh Circuit Court of Appeals in

in filing a disclaimer after the decrees in the *Monarch* and *Macomb* cases (Tr. 321-5).

Upon appeal the Circuit Court of Appeals for the Seventh Circuit, after briefs and oral argument, postulating validity, certified to this Court certain questions relating to the propriety and necessity for filing a disclaimer (No. 590, October Term, 1935). The inherencies of the questions certified made answer impossible without an examination into facts not stated, and this Court declined to answer. It did, however, make guiding observations in *Triplett* v. *Lowell*, and *The Mantle Lamp of America* v. *Aluminum Products Co.*, 297 U. S. 638.

Thereafter, upon reargument of the entire case before the Circuit Court of Appeals for the Seventh Circuit, that Court failed or declined to pass upon and determine the issues raised by the disclaimer questions involved, though helpful guidance was at hand in the decision in *Triplett* v. *Lowell*. The Circuit Court of Appeals failed to reverse the Findings and Conclusions of the District Court insofar as they pertained to invalidation of the entire patent for failure to file a disclaimer. It adhered to its previous rulings in the *Monarch* and *Macomb* cases, though upon a different record and additional testimony (Tr. 494).

B. Questions Presented.

1. Whether the conflict in decision between the Circuit Court of Appeals for the Seventh Circuit and the Sixth Circuit in the same matter, viz., the validity of the Blair patent No. 1,435,199, should be resolved.

2. Whether the said patent is invalid in all of its claims because of failure to file a disclaimer, an issue as to which the Circuit Court of Appeals made no disposition even after certifying questions thereon to this Court, save as

such disposition may be spelled out of an affirmance of the decree of the District Court which was in part based upon a finding that all of the claims of the patent in suit were invalid (Tr. 325).

II.

REASONS FOR GRANTING THE WRIT.

The discretionary power of this Court is invoked upon the following grounds:

1. The decision of the Circuit Court of Appeals for the Seventh Circuit is in real and direct conflict with a decision of the Circuit Court of Appeals for the Sixth Circuit on the question of validity of the same claims of one patent.*

   a. The conflict in decision is emphasized by the fact that each Circuit Court of Appeals calls attention to the contrary decision of the other.

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*The statement that there is a conflict in decision is supported by the following short quotations from the opinions:

In the *Monarch* and *Macomb* cases, claims 1, 4-7, 10-14, 17, 18, 21-24, were involved. In the *Macomb* case, 22 F. (2) 93, the Circuit Court of Appeals for the Seventh Circuit, speaking of the patentee Blair said:

> "He has assembled—combined in the ordinary sense—old and well known elements, but he has not made an invention."

In the *Monarch* case, 22 F. (2) 95, the same Court said:

> "For the reasons stated in our opinion in the *Macomb* Case, we hold the patent invalid."

In the instant suit, the claims in issue include all of the claims in issue in the *Monarch* and *Macomb* cases. In its

b. The conflict in decision and necessity for review is further emphasized by the fact that in the instant case the Court of Appeals postulated validity by certifying questions relating to disclaimers.

2. The decision of the Court of Appeals in the instant case is probably in conflict with the weight of authority in that in following its previous rulings in the *Monarch* and *Macomb* cases, it combined separate elements from prior art patents to anticipate and render non-inventive the patentee's device.

3. The application of the rules relating to disclaimers, to the facts of this case, were of sufficient importance for the Circuit Court of Appeals to certify questions relating thereto. The certified questions could not be answered by this Court, and have not been answered by the Circuit Court

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opinion in the instant suit, the Circuit Court of Appeals for the Seventh Circuit said (Tr. 494):

> "Although the validity of this patent is a close question, we are not convinced that the additional testimony is sufficient to warrant us in departing from the former holdings of this Court in the *Macomb* and *Monarch* cases."

The opinion of the Circuit Court of Appeals for the Sixth Circuit ordered

> "the usual decree for plaintiff on claim 1, and without prejudice to any rights of the plaintiff under any other claim" (Tr. 227).

The opinion of the Circuit Court of Appeals in the instant suit recognizes the conflict with the Sixth Circuit; and the Circuit Court of Appeals of the Sixth Circuit in its opinion said:

> "We are constrained to the other conclusion from that reached by the Seventh Circuit Court of Appeals" (Tr. 227).

of Appeals. A determination should be made, not only for the litigants but for the public generally,

a. whether there was unreasonable delay in filing a disclaimer if one was necessary;

b. whether the claims not previously held invalid constitute "a material and substantial part of the thing patented" so as to require a disclaimer thereof.

WHEREFORE your petitioner respectfully prays that a writ of certiorari be issued under the seal of this Court, directed to the United States Circuit Court of Appeals for the Seventh Circuit, commanding that Court to certify and to send to this Court, on a day to be designated, a full and complete transcript of the record and of all proceedings in the Circuit Court of Appeals had in this cause, to the end that this cause may be reviewed and determined by this Court; that the judgment of the Circuit Court of Appeals be reversed; and that petitioners be granted such other and further relief as may seem proper.

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BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

I.

OPINIONS OF THE COURTS BELOW.

No written opinion was rendered by the District Court. Instead Findings of Fact and Conclusions of Law were filed by District Judge John P. Barnes on March 13, 1934. These Findings and Conclusions appear on pages 321-325 of the record; and are otherwise unreported.

The opinion of the Circuit Court of Appeals (Tr. 493) was filed November 28, 1936. It is reported in 86 Fed. (2) 509.

Other Allied Opinions.

Of collateral interest to the decisions in this proceeding are the following opinions, all relating to the validity of the patent in suit:

Macomb Manufacturing Co. v. *Mantle Lamp Company of America*, 22 Fed. (2) 93 (C. C. A. 7). Opinion rendered May 28, 1927, petition for rehearing denied December 5, 1927, in which the patent was held invalid for lack of invention.

Monarch Company, Inc., et al. v. *Mantle Lamp Company of America*, 22 Fed. (2) 95, (C. C. A. 7). Opinion rendered May 28, 1927, petition for rehearing denied December 5, 1927. Follows the ruling in the *Macomb* case.

Mantle Lamp Company of America v. *George H. Bowman Company*, 53 Fed. (2) 441, (C. C. A. 6). Opinion rendered November 3, 1931, in which patent was held valid and infringed.

Knapp-Monarch Co. substituted plaintiff, v. *Mantle Lamp Company of America*, 81 Fed. (2) 428, (C. C. A. 7). Opinion rendered January 18, 1936, petition for rehearing denied February 25, 1936, in which the injunction against the prosecution of a co-pending case in the District Court of the United States, Western District of Missouri, was dissolved.

Triplett v. *Lowell* and *Mantle Lamp Company of America* v. *Aluminum Products Company*, 297 U. S. 638. Answer to questions certified to the Supreme Court by the Circuit Court of Appeals for the Seventh Circuit herein, relating to the necessity for Petitioner to have filed a disclaimer.

II.

JURISDICTION.

The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code (28 U. S. C. 347, as amended).

The date of the decree to be reviewed is November 28, 1936 (Tr. 493). The petition for writ of certiorari and this brief in support thereof were filed February 27, 1937.

Cases believed to sustain the jurisdiction are *Holland Furniture Co.* v. *Perkins Glue Co.*, 277 U. S. 245; *Layne and Bowler Corp.* v. *Western Well Works, Inc.*, 261 U. S. 387, 393; *Simmons* v. *Grier Bros.*, 258 U. S. 82; *Abercrombie & Fitch Co.* v. *Baldwin*, 245 U. S. 198.

III.

STATEMENT.

The facts are sufficiently stated in the petition. Emphasis is directed to the diversity of opinion between Circuit Courts of Appeals on the same matter; and to the failure of the Circuit Court of Appeals to make a determination of the disclaimer issues involved, even though those issues were considered of such importance that that Court certified questions to this Court relating to such issues, and this Court gave helpful guidance in its decision in *Triplett* v. *Lowell*, 297 U. S. 638.

IV.

SPECIFICATION OF ERRORS.

The errors which the petitioner will urge, if the writ of certiorari is granted, are that the Circuit Court of Appeals for the Seventh Circuit erred:

1. In holding the claims in suit of the patent involved invalid.

2. In adopting its rulings in the *Monarch* and *Macomb* cases wherein the patent in suit was held invalid by finding separate and non-combinable elements in separate patents in the prior art.

3. In applying its rulings in the *Monarch* and *Macomb* cases to a record containing the additional testimony included in the *Bowman* case in the Sixth Circiut.

4. In affirming the decree of the District Court which was in part based upon a finding of non-infringement (Tr. 325).

5. In failing to reverse the decree of the District Court holding all of the claims of the patent invalid for failure to file disclaimer.

V.

SUMMARY OF ARGUMENT.

The points of the argument follow the specification of errors relied upon and for the sake of brevity are not repeated.

VI.

ARGUMENT.

The Blair Patent is Valid.

Blair departed from the vacuum type of heat-insulated receptacle. He relied for heat-insulation upon a non-conducting packing between the outer jacket and the container. To prevent the escape or transfer of heat from the container to the jacket, he made contact between them only through an insulating bond at the neck. This uniting bond pendantly supported the container and served also as a seal to exclude air and moisture from the packing material. He was the first one who put upon the market a satisfactorily efficient, portable insulated jug.

The dominant characteristic of the invention consisted in hanging the heavy inner container to the protective metal jacket at the neck of each by an insulating seal and bond. Thus he was enabled to avoid any extensive contact for heat transfer between the receptacle and the outer casing.

The Circuit Court of Appeals for the Sixth Circuit and the Circuit Court of Appeals for the Seventh Circuit are in direct conflict upon the validity of the Blair patent. Each Court has been fully advised of the opinions and records in the other circuit (Tr. 221, 494). The Circuit Court of Appeals for the Seventh Circuit indicates doubt as to the correctness of its determination. It postulated validity by certifying questions relating to disclaimer is-

sues (No. 590, October Term, 1935). In its latest opinion, it frankly states that the validity of the patent is a close question (Tr. 494).

Except for the conclusion of the District Court in the instant suit that claim 9 is void for anticipation (Tr. 324), there has not been in any of the litigation over this much litigated patent, any doubt expressed as to the novelty of the Blair device, nor has any doubt ever been expressed as to its commercial importance and widespread use.

The conflict between the two Circuit Courts of Appeals should be resolved.

The Combining of Separate Elements from Prior Art Patents Has Been Condemned by This Court.

The Circuit Court of Appeals for the Seventh Circuit in the *Monarch* and *Macomb* cases selected three patents, Heath No. 211,092 (Tr. 356), Clisbee No. 358,732 (Tr. 360), and Fox No. 438,149 (Tr. 366); and indicated that the combination of the various elements selected therefrom required only mechanical skill and not inventive genius. In two respects this was error. In the first place, the patents selected do not contain the elements of the Blair device as pointed out by the opinion of the Circuit Court of Appeals for the Sixth Circuit (Tr. 266). In the second place, lack of invention cannot be spelled out in this way.

The Clisbee patent relates to a double-walled metallic can for keeping coffee hot; the inner can is supported from the outer can by direct metallic contact. There is no suggestion of a bond or seal nor means for uniting a frangible container to a metallic jacket. The facility of heat transfer at the path of direct metallic contact is obvious.

The Heath and Fox patents do not relate to heat-insulation at all. They are packing containers to prevent an enclosed bottle from being broken in transportation. Fox is a wooden packing case for transporting a glass carboy. This glass container rests upon its bottom. Around the neck of the carboy and between it and the hole in the top of the wooden box, Fox applied plaster of Paris. He said that it was to exclude water. The Circuit Court of Appeals for the Sixth Circuit found plaster of Paris not effective for this purpose. In any event there was not the suggestion of a bond for pendent support or heat-insulation.

The Heath patent is a bottle protected for shipping. There is no suggestion of pendant support, a bond, or a seal.

Even assuming that the Heath, Clisbee and Fox patents contain separately the elements of the Blair combination, (which they do not) selecting of elements from various prior art patents and combining them to anticipate or render non-inventive a later structure, has been condemned. *Bates* v. *Coe*, 98 U. S. 31; *Topliff* v. *Topliff*, 145 U. S. 156; *Carnegie Steel Co.* v. *Cambria Iron Co.*, 185 U. S. 404; *Webster Loom Co.* v. *Higgins*, 105 U. S. 508; *Barbed Wire Patent case*, 143 U. S. 275.

The conclusion of the Circuit Court of Appeals for the Sixth Circuit upon the finding of the elements of Blair in the prior art and the combining of them is expressed in a single sentence (Tr. 226):

> "Even if this were a case where lack of invention could be spelled out in that way, the patents do not seem to us sufficient for that result" (Tr. 226).

The Record in the Instant Case Supports a Different Conclusion from the Record in the Monarch and Macomb Cases.

The record in the instant case, like the record before the Circuit Court of Appeals for the Sixth Circuit in the *Bowman* case, but unlike the record in the *Macomb* and *Monarch* cases, contains the additional testimony of Terry (Tr. 60, *et seq.*) and Brainard Tr. 46, *et seq.*).

Terry was in the business of making heat-insulated receptacles. He bought a Blair jug. His company took it apart to see how it was made. It was decided to make a similar one. The value of the seal and bond at the neck was not apparent and failure resulted from resting the inner container on a metal tripod which, in turn, rested on the bottom of the outer container. For his own use Terry selected a Blair jug rather than one of his own manufacture (Tr. 60-64).

Brainard likewise was engaged in the manufacture of heat-insulated receptacles. He was president of the Macomb Manufacturing Company. His attempts to make a successful jug were failures until the Blair structure was copied (Tr. 46-48).

The Circuit Court of Appeals for the Seventh Circuit was not convinced that the additional testimony was sufficient to warrant it in departing from its prior rulings in the *Macomb* and *Monarch* cases (Tr. 494). On the other hand, the Circuit Court of Appeals for the Sixth Circuit, commenting upon the additional evidence, said (Tr. 227):

> "this proof is so important that it alone goes far toward justifying a different result here."

But even without such additional evidence the Sixth Circuit Court of Appeals was of the opinion that in the *Monarch* and *Macomb* cases it would have resolved the questions thereon on those records in favor of the petitioner since, in commenting on the evidence in the *Monarch* and *Macomb* cases it said (Tr. 225):

> "Seldom is there a record of failure by other things and success by the patented means more helpful than this is upon the issue of invention".

The Claims in Issue of the Blair Patent are Infringed.

There is no real issue of infringement. The District Court found (Tr. 325) that the claims were limited to the use of a particular character of bond and as so limited were not infringed. The bond used by the defendant is sulphur rather than the preferred bond mentioned in the specification of the Blair patent. The same form of bond was used in the accused structure in the case in the Sixth Circuit (Tr. 226). The Circuit Court of Appeals for the Sixth Circuit found infringement (Tr. 226).

The sulphur bond of the defendant is used for the same purpose and accomplishes the same result as the preferred example given in the patent in suit. The requirement of claim 1 is that the frangible container shall be "bonded to and pendantly supported" from the metallic jacket. The accused structure precisely falls within the language of the claim.

There Has Been No Determination Made by a Reviewing Court of the Disclaimer Issues Involved.

After the first hearing in the Circuit Court of Appeals in the instant case, that Court certified three questions to this Court on the subject matter of disclaimers. Be-

cause of a lack of factual basis, the questions could not be answered categorically. However, guidance in answering the questions was furnished by the opinion of this Court in *Triplett* v. *Lowell*, 297 U. S. 638. The question of whether an unreasonable delay and neglect in filing a disclaimer existed is still unanswered unless an answer can be spelled out from the affirmance of the decree of the District Court based upon the finding that all claims were void for failure to file disclaimer. Likewise, the question of whether a material and substantial part of the thing patented and definitely distinguishable from the claims previously held invalid, so as to admit of the application of the disclaimer statutes, is still unanswered. These determinations should be made not only for the interest of the particular litigants but for the public at large.

A correct interpretation of the opinion of the Supreme Court on the certified questions herein in *Triplett* v. *Lowell, etc.*, 297 U. S. 638, must have resulted in a different disposition of the instant case.

VII.

CONCLUSION.

The questions presented by this case should be determined by this Court. It is earnestly urged that the petition be granted.

Respectfully submitted,

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